

REMARKS/ARGUMENTS

Claims 24-62 are pending and stand rejected in this application. Claims 1-23 were previously withdrawn from consideration. In view of the Examiner's earlier restriction requirement, applicant retains the right to present claims 1-23 in a divisional application. Claims 24, 31, 46 and 52 have been amended to further clarify the claimed invention, claims 30 and 32-35 have been cancelled, and claim 63 has been added. The cancellation of claims 30 and 32-35 shall not be construed as acquiescence in any ground of rejection as Applicants reserve the right to prosecute the originally filed claims in the future. The proposed amendments to the claims and the comments in the office action regarding claims 24-62 are now addressed in turn.

Claim Rejections Under 35 USC § 103(a)

Claims 24, 29, 31 and 38-40 were rejected under USC § 103(a) as allegedly being unpatentable over Zonana *et al.* (U.S. Patent 6,355,782) in view of Dong *et al.* (U.S. Patent 6,361,947). Specifically, the office action asserts that it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to combine the method of Zonana with the detection method of Dong.

Specifically, with regards to Claim 29, it was stated that Zonana discloses the use of PCR products as driver.

With regards to claim 31, the office action alleges that "Dong teaches restriction digestion of the sample, which would result in more than ten noncontiguous regions of driver".

With regards to Claims 38 and 39, it was stated that Zonana discloses a driver with a biotin tag that binds to streptavidin magnetic beads.

Claim 40 was similarly rejected over the alleged disclosure in Zonana for the separation of a subset of complementary tester nucleic acids from the subset of immobilized complementary driver nucleic acids using the biotin streptavidin interaction.

Applicants respectfully traverse all of the above rejections and submit that the instant invention is not obvious in light of the prior art for the reasons previously presented, as well as those that follow.

In order to render a claimed invention prima facie obvious, a prior art reference must teach or reasonably suggest the practicing of the invention, as well as suggest a reasonable likelihood of success in carrying out the invention. The Federal Circuit has stated that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." (See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).) Further, in *In re Fritch* (972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992)), the Federal Circuit stated that "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." The court emphasized that

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